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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,969	04/10/2006	Kwai Ming Cheung	010180.00047	1639
22907 7590 10/25/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER CHU, YONG LIANG	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,969	Applicant(s) CHEUNG ET AL.	
	Examiner Yong Chu	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 5, 11-14 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 15, 16 and 25 is/are rejected.
- 7) ☒ Claim(s) 1-4, 6-10, 15, 16, and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23, and 25 are pending in the instant application.

Information Disclosure Statement

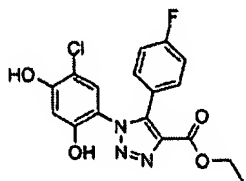
Applicants' Information Disclosure Statement, filed 12/22/2005, has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

Priority

This application is a 371 of PCT/GB04/02755 filed 06/24/2004, and claims the foreign priority of U.K. Patent Applications 0315111.5 filed 06/27/2003.

Response to Lack of Unity

Applicants' election *without traverse* of Group I (claims 1-21, and 25) and elected



a species of Example 3 of the disclosure in the reply filed 09/25/2007 is acknowledged.

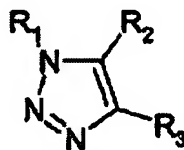
Status of the Claims

Claims 1-21, 25 (in part), and Claims 22 and 23 are further withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR 1.142(b) due to the lack of unity of invention. The withdrawn subject matter is

patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



A compound of the Formula (IE) , wherein:

R^1 is $-\text{Ar}^1-(\text{Alk}^1)_s-(\text{Z})_r-(\text{Alk}^2)_p-\text{Q}$, wherein Ar^1 is an optionally substituted phenyl, $s = r = p = 0$, and Q is a hydrogen;

R^2 is an optionally substituted phenyl;

R^3 is a carboxyl ester group, or a composition comprising the said compound in claim 1.

As a result of the election and the corresponding scope of the invention identified supra, claims 5, 11-14, 17-21, and the remaining subject matter of claims 1-4, 6-10, 15-16, and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups, which are chemically recognized to differ in structure, function, and reactivity. Therefore, claims 1-4, 6-10, 15-16, and 25 will be examined on the merits.

Claim Objections

Claims 1-4, 6-10, 15-16 and 25 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-10, 15-16, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definition of the terms "R₂" and "R₃" are is not clear enough for one skilled in the art, which render claim 1 indefinite. Specifically, the phrases "R₂ ... if not absent R₁ is hydrogen.." and "R₃ ... if not absent R₂ is hydrogen.." render the claims indefinite. Applicant needs to clearly define what R₂ and R₃ stand.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definition of the term "R" is defined as one or more optional substituents. However, it is not clear what substituents stand for.

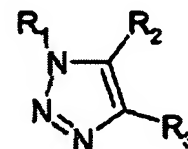
Claim Rejections - 35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 15-16, and 25 are rejected under 35 U.S.C. 102 (b) as being anticipated by Kandeel et al., *Afinidad* (1993), 50 (447), pp. 316-18 ("Kandeel et al").



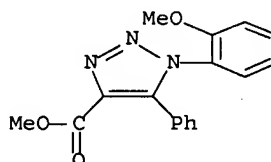
Applicants' claims relate to a compound of the Formula (IE)

wherein:

R^1 is $-\text{Ar}^1-(\text{Alk}^1)_p-(\text{Z})_r-(\text{Alk}^2)_s-\text{Q}$, wherein Ar^1 is an optionally substituted phenyl, $s = r = p = 0$, and Q is a hydrogen;

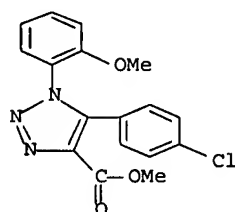
R^2 is an optionally substituted phenyl;

R^3 is a carboxyl ester group, or a composition comprising the said compound in claim 1.



Kandeel et al. disclose the compounds

(CAS RN 154581-



28-9), and (CAS RN 154581-29-0). These two compounds

anticipate the instant claims 1-4, 6, 15-16, and 25, wherein R^1 is $-\text{Ar}^1-(\text{Alk}^1)_p-(\text{Z})_r-(\text{Alk}^2)_s-\text{Q}$, wherein Ar^1 is a MeO -substituted phenyl, $s = r = p = 0$, and Q is a hydrogen; R^2 is a phenyl; and R^3 is a methylcarboxyl ester group, or a composition comprising the said compound in claim 1.

Conclusion

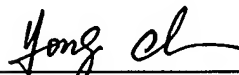
- Claims 1-4, 6-10, 15-16, and 25 are objected.
- Claims 1-4, 6-10, 15-16, and 25 are rejected.



Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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